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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,966	09/06/2001	Larry Neil Mackey	U 013595-2	6640

27752 7590 02/09/2006

THE PROCTER & GAMBLE COMPANY  
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CINCINNATI, OH 45224

EXAMINER
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JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/914,966	MACKEY ET AL.	
	Examiner	Art Unit	
	Cheryl Juska	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Response to Amendment***

2. Applicant's amendment filed December 7, 2005, has been entered. Claims 1-32 are cancelled and replaced with new claims 33-52.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 33-35 and 37-52 are rejected under 35 USC 103(a) as being unpatentable over US 4,243,480 issued to Hernandez et al.

New claims 33-35 and 37-52 are of identical scope as that of claims 11-13, 15-29, 31, and 32 as amended in the response filed September 27, 2004. As such, said claims are rejected for the reasons set forth in sections 4, 6, and 7 of the Office Action dated December 10, 2004.

Art Unit: 1771

5. Claim 36 is rejected under 35 USC 103(a) as being unpatentable over the cited Hernandez reference in view of US 5,516,815 issued to Buehler et al.

New claims 36 is of identical scope as that of claim 14 as amended in the response filed September 27, 2004. As such, said claim is rejected for the reasons set forth in section 5 of the Office Action dated December 10, 2004.

### *Response to Arguments*

6. Applicant's arguments filed with the amendment of December 7, 2005, have been fully considered but they are not persuasive.

7. Applicant traverses the above rejections by asserting that the claimed invention is "not rendered obvious over Hernandez because Hernandez fails to teach each and every element of the claims (Remarks, page 1, 9<sup>th</sup> paragraph). In response, the examiner agrees that Hernandez does not teach "each and every element" of the claimed invention. As such, the rejection is not a 102 anticipation rejection, but rather a 103 rejection. However, it is reasserted that the claims are obvious over the Hernandez reference.

As stated in previous Office Actions, Hernandez teaches a starch fiber diameter of 10-500 microns rather than the presently claimed less than 10 microns. However, it is argued that the claims are obvious over the teachings of Hernandez. Specifically, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215. In the instant case, decreasing the fiber diameter will produce a softer, more absorbent product. Therefore, said claims are rejected as being obvious over the cited Hernandez reference.

Art Unit: 1771

8. Applicant also argues that Hernandez “only teaches making one diameter of starch fiber; namely, a fiber having an average fiber diameter of 65  $\mu\text{m}$ ” (paragraph spanning 1<sup>st</sup> and 2<sup>nd</sup> pages of Remarks). This statement is incorrect since Hernandez explicitly teaches the starch fiber may be 10-500 microns in diameter (col. 3, lines 59-61). Applicant also asserts “Hernandez never explicitly teaches or enables one of ordinary skill in the art how to make a starch fiber having a diameter of less than 10  $\mu\text{m}$  using its solvent spinning process” (paragraph spanning 1<sup>st</sup> and 2<sup>nd</sup> pages of Remarks). In response, Hernandez is not required to have such a teaching since the rejection is not a 102 anticipation rejection.

9. Additionally, applicant argues its method of solvent spinning to produce the fiber of the claimed diameter and the flexibility properties obtained from such a fiber diameter (Remarks, page 2). It is noted that the features upon which applicant relies (i.e., method of making and properties thereof) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, applicant’s arguments are found unpersuasive and the above rejection stands.

10. Regarding the Mackey Declaration under 1.132, said declaration is insufficient to overcome the prior art rejections. Specifically, said declaration is insufficient for the reasons set forth above for why applicant’s arguments are not found persuasive. Additionally, said declaration is not commensurate in scope with the present claims. In other words, applicant is not claiming a method of making the starch fiber, including the “extremely high attenuation forces,” but rather applicant is merely claiming a fiber having a specified diameter. Therefore, said declaration is insufficient and the above rejection stands.

***Conclusion***

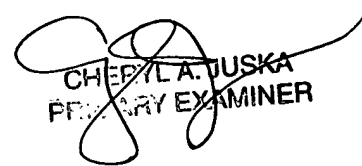
11. This is an RCE of applicant's earlier Application No. 09/914,966. All claims are drawn to the same invention claimed in the earlier application (i.e., Amendment filed September 27, 2004) and were finally rejected on the grounds and art of record in the Office Action of December 10, 2004. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1771

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER